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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/913,613      | 08/15/2001  | Jorg Vortkort        | VORTKORTETAL        | 2511             |

25889 7590 03/25/2003

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EXAMINER

CHEUNG, WILLIAM K

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1713

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 09/913,613             |  | VORTKORT ET AL.     |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | William K Cheung       |  | 1713                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                                              |                                                                             |
|--------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other:                                          |

### **DETAILED ACTION**

1. In view of Preliminary Amendment (Paper No. 30) filed August 15, 2001, claims 1-20 have been cancelled and new claims 21-38 have been added. Claims 21-38 are pending.

### ***Claim Objections***

2. Claims 22-28, 30-38 are objected to because of the following informalities:

Claim 22 (line 2), claim 23 (line 2), claim 24 (line 2), claim 25 (line 2), claim 26 (line 2), claim 27 (line 2), claim 28 (line 2), claim 30 (line 2), claim 31 (line 2), claim 32 (line 2), claim 33 (line 2), claim 34 (line 2), claim 35 (line 2), claim 36 (line 2), claim 37 (line 3), claim 38 (line 2), the recitation "characterized in that" is considered awkward, please amend it to "wherein".

Claim 37 (line 2-3), the unnecessary spacing in claim 37 (line 2-3) can be confusing. Please delete the unnecessary spacing.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 21-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 (line 5-7), the recitation "a rubber (C) .....being compatible with the thermoplastic synthetic resin (A) in regard to the phase inversion" is considered indefinite because the specification fails to describe/define what "phase inversion" is and how "phase inversion" is related to the compatibility of rubber (C). Without a proper description on this subject matter, one of ordinary skill would not know what "phase inversion" is and consequently would not be able to appreciate the invention of claims 21-38. Appropriate correction without the introduction of new matter is required.

The phrase "preferably" in claim 23 (line 4), claim 25 (line 3), claim 26 (line 3), claim 27 (line 4), claim 28 (line 5), claim 32 (line 7), claim 34 (line 4), claim 37 (line 6) renders the claims indefinite because the use of the phrase "preferably" to link a broad range of values with a narrower range of values renders the claim to be indefinite. It is

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not clear which range controls the actual metes and bounds of the claimed subject matter.

Claim 21 recites the limitation "the standard blend ingredients" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitation "the mixture" in line 11. There is insufficient antecedent basis for this limitation in the claim. Is the recited "the mixture" referred to the claimed "thermoplastic vulcanizate" of claim 21 (line 1) or the claimed "standard blend ingredients (E)" of claim 21 (line 9)? As written, one of ordinary skill in art would not know what "the mixture" is being referred to. Although applicants' specification (page 9, paragraphs 2 and 3) describes that the standard ingredients a blend comprises a filler and additives, applicants must also recognize that claim 21 as claimed does not restrict the standard blend ingredients (E) having components A, B, C, D or mixture thereof as a filler.

Therefore, because claim 21 is incomprehensible, the examiner is unable to understand the metes and bounds of claims 21-38. Therefore, the examination of claims 21-38 cannot proceed further.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (703) 305-0392. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5885 for regular communications and (703) 305-5885 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

William K. Cheung



Patent Examiner

March 21, 2003